

Docket No.: P-0204



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PATENT *SPW*

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES**

In re Application of

Confirmation No.: 9587

Chin Tae KIM, Sung Yeob LEE and
Tae Gyu LEE

Group Art Unit: 3628

Serial No.: 09/837,291

Examiner: Chin Tae Kim

Filed: 4/19/2001

Customer No.: 34610

For: PURCHASING SYSTEM ON INTERNET AND METHOD THEREOF

TRANSMITTAL OF APPEAL BRIEF

U.S. Patent and Trademark Office
Customer Window, Mail Stop Appeal Brief-Patents
Randolph Building
401 Dulany Street
Alexandria, Virginia 22314

Sir:

Submitted herewith is Appellants Appeal Brief in support of the Notice of Appeal filed January 25, 2007. Please charge our credit card for the Appeal Brief fee of \$500.00 (please see completed credit card form PTO-2038).

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 16-0607 and please credit any excess fees to such deposit account.

Respectfully submitted,
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Confirmation No.: 9587

Chin Tae KIM, Sung Yeob LEE and Tae
Gyu LEE

Group Art Unit: 3628

Serial No.: 09/837,291

Examiner: Chin Tae Kim

Filed: April 19, 2001

Customer No.: 34610

For: PURCHASING SYSTEM ON INTERNET AND METHOD THEREOF

APPEAL BRIEF

U.S. Patent and Trademark Office
Customer Window, Mail Stop Appeal Brief-Patents
Randolph Building
401 Dulany Street
Alexandria, Virginia 223134

Sir:

This appeal is taken from the rejection of claims as set forth in the Office Action of April 7, 2006 (hereinafter the Office Action). In accordance with 37 C.F.R. §41.37, Appellants address the following items.

REAL PARTY IN INTEREST

The real party in interest is the assignee, LG Electronics Inc. The assignment document is recorded at Reel 011733 and Frame 0140.

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RELATED APPEALS AND INTERFERENCES

There are no related appeals and interferences.

STATUS OF THE CLAIMS

This is an appeal from the Final Rejection dated April 7, 2006 of claims 1, 3-29 and 34.

No other claims are pending.

STATUS OF AMENDMENTS

All Amendments filed in this application have been entered. A copy of appealed claims 1, 3-29 and 34 appears in the attached Claims Appendix.

SUMMARY OF THE CLAIMED SUBJECT MATTER

As stated in 37 C.F.R §41.37(c)(v), Appellants are providing the following explanation of each of the independent claims 1, 8, 13, 16, 20, 26 and 34 involved in this appeal. This explanation refers to the specification and drawings. The following is merely an example summary and is not intended to be a discussion of the full and entire scope of the claims. Other interpretations, configurations and embodiments are also within the scope of the pending claims.

Independent Claim 1

Independent claim 1 recites an Internet-based automatic purchasing method (Fig. 1B) performed on at least one server (4a) connected to the Internet (3). The method may include inputting a notice of tender by a buyer 1 on a server 4a at a purchasing site 4, the notice including purchasable items. For example, Fig. 1 shows a buyer 1 and network-based system including at least one server 4. See also, page 9, paragraphs [34, 36].

The method may also include applying for a new registration by at least one company desiring to join the tender. For example, Fig. 1B shows registration application for cooperation company by a new company (S2). See also, page 11, paragraphs [37, 38].

In addition, the method may include screening the at least one company to determine whether the at least one company applying for a new registration satisfy a certain condition set in advance. For example, Fig. 1B shows determining if the new company satisfies a certain condition (S3). See also, page 13, paragraph [41].

The method may further include registering the at least one company as cooperation companies when the companies satisfy the certain condition set in advance. For example, Fig. 1B shows registering the new company as a cooperation company (S5). See also, page 13, paragraph [42].

The method may include sending a request for quote to the cooperation companies. For example, Fig. 1B shows RFQ transmission to registered companies (S7). See also, page 13, paragraph [42].

The method may also include sending bids to the purchasing site by the cooperation companies in response to the request for quote. For example, Fig. 1B shows the registered companies transmit the RFQ to a purchase site (S8). See also, page 14, paragraph [45].

Further, the method may include selecting a selected cooperation company to supply the purchasable items by automatically screening the registered cooperation companies. For example, Fig. 1B shows selecting an optimum cooperation company (S9). See also, page 15, paragraph [46].

The method may include wherein the screening, the registering, the sending the request, and the selecting are all performed automatically by the at least one server. For example, Fig. 1B shows at least one server 4a. See also, page 20, paragraph [58].

Independent Claim 8

Independent claim 8 recites an Internet-based automatic purchasing system. For example, Fig. 8 shows an automatic purchasing system. See also, page 16, paragraph [49]. The system may include a web server, the web server including a program for controlling the system's operations, the operations including notice of tender operations and ordering operations. For example, Fig. 8 shows a web server 82 and program 83. See also, page 16, paragraph [49].

The system may further include an internal database, the internal database providing information related to purchases. For example, Fig. 8 shows an internal database 86A. See also, page 16, paragraph [49].

The system may also include an external database, the external database providing information to cooperation companies. For example, Fig. 8 shows an external database 86B. See also, page 16, paragraph [49].

Independent Claim 13

Independent claim 13 recites an Internet-based joint purchasing system. For example, Fig. 9 shows an Internet-based joint purchasing system. See also, page 18, paragraph [53].

The system may include a plurality of region terminals for inputting order information about a purchase item required by a plurality of companies in a prescribed region. For example, Fig. 9 shows a plurality of region terminals 91A, 92A, 93A and a plurality of business establishments A, B, C. See also, page 18, paragraph [53].

The system may also include a plurality of region servers for combining and storing the order information from the plurality of region terminals about the purchase item and transmitting the combined order information through a communication network. For example, Fig. 9 shows a plurality of region servers 91B, 92B, 93B. See also, page 18, paragraph [53].

The system may further include a main server, the main server receiving the combined order information about the purchase item transmitted from the region servers and performing a notice of tender for a joint purchasable item through the Internet to cooperation companies. For example, Fig. 9 shows a main server 94A, the Internet 95 and cooperation companies 96A-96N. See also, page 18, paragraph [53].

Independent Claim 16

Independent claim 16 recites an Internet-based joint purchasing method (Fig. 10). The method may include inputting a plurality of orders for an item to purchase. For example, Fig. 10 shows purchasing item order information input from each business establishment (S100). See also, page 19, paragraph [54].

The method may also include transmitting the inputted orders to a main server. For example, Fig. 10 shows transmitting the inputted orders to a main server (S102). See also, page 19, paragraph [54].

The method may further include performing a notice of tender for the item, wherein the plurality of orders are jointly tendered in the notice of tender to a plurality of cooperation companies through the Internet. For example, Fig. 10 shows performing a notice of tender for the item (S105). See also, pages 19-20, paragraphs [55-57].

Independent Claim 20

Independent claim 20 recites a method of matching vendors to buyers through a network. The method may include identifying whether vendors satisfy minimum attributes set by a buyer. For example, Fig. 1B shows identifying whether vendors satisfy minimum attributes (S3). See also, page 13, paragraph [41].

The method may also include registering the vendors that satisfy the minimum attributes. For example, Fig. 1B shows registering the vendors that satisfy the minimum attributes (S5). See also, page 13, paragraph [42].

The method may further include identifying the buyer's vendor selection criteria. For example, see, page 6, paragraph [18] and page 15, paragraph [46].

In addition, the method may include notifying the vendors of the vendor selection criteria. For example, see, page 6, paragraph [18] and page 13, paragraph [43].

The method may include accepting bids from the vendors. For example, see, page 6, paragraph [18] and page 14, paragraph [45].

Further, the method may include selecting, by the buyer, a selected vendor from the vendors that satisfy the minimum attributes according to one or more of the vendor selection criteria. For example, see, page 6, paragraph [18] and page 15, paragraph [47].

Independent Claim 26

Independent claim 26 recites a network based sales generation system (Fig 1B). The network may include a spatial location engine to determine criteria of a buyer and attributes of a plurality of vendors. For example, see, Fig. 1B, 4a and pages 6-7, paragraph [19] and page 9, paragraph [34].

The network may also include a registering unit to register vendors which satisfy set minimum attributes. For example, see, Fig. 1B, 4a and pages 6-7, paragraph [19] and page 9, paragraph [34].

The network may further include a database containing information regarding the registered vendors. For example, see, Fig. 1B, 4b and pages 6-7, paragraph [19] and page 9, paragraph [34].

Moreover, the network may include an analyzing unit to collect selection criteria from the buyer. For example, see, Fig. 1B, 4a and pages 6-7, paragraph [19] and page 9, paragraph [34].

In addition, the network may include an engine to automatically select a qualified vendor for the buyer based on the database information and the selection criteria. For example, see, Fig. 1B, 4a and pages 6-7, paragraph [19] and page 9, paragraph [34].

Independent Claim 34

Independent claim 34 recites a method for selecting a first party for a second party for engaging in a transaction (Figs 1A, 1B). The method may include means for entering a request identifying at least one criterion for a transaction by the second party through a network. For example, see, Fig. 1B, 3, 4a and page 7, paragraph [21] and page 9, paragraph [34].

The method may further include means for qualifying the first party to a set of minimum attributes. For example, see, Fig. 1B, 4a and page 7, paragraph [21] and page 9, paragraph [34].

The method may also include means for identifying a qualified first party to engage in the transaction based on the at least one criterion. For example, see, Fig. 1B, 4a and page 7, paragraph [21] and page 9, paragraph [34].

In addition, the method may include means for providing an identification of the first and second parties to engage in the transaction. For example, see, Fig. 1B, 4a and page 7, paragraph [21] and page 9, paragraph [34].

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 20-26, 28-29 and 34 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0014318 (De La Motte et al.). Claims 1 and 3-19 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the Appellants' disclosure. Claim 27 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over De La Motte et al. Appellants assert that each of the claims stands and falls separately from one another.

ARGUMENTS

The present application contains seven independent claims, namely independent claims 1, 8, 13, 16, 20, 26 and 34. These claims contain different features as may be evidenced by the specifically claimed features and as may be pointed out below. For ease of illustration and discussion, similar types of claims (or claim features) may be discussed with respect to each other. This is not an admission that the claims are the same or that they stand or fall together. Rather, this is an attempt to narrow the number of issues and to limit the number of arguments. While arguments may be similar for different claims, it should be understood that differently claimed features are expressly used.

Appellants assert that the cited references do not disclose, suggest or render obvious the limitations in the combination of each of pending claims 1, 3-29 and 34 of the present application. Appellants respectfully request that all current rejections be withdrawn and that

the decision of the Examiner be reversed based on the following.

35 U.S.C. §102 Rejections

To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 U.S.P.Q.2d (BNA) 1429, 1431 (Fed. Cir. 1997). The identical invention must be shown in as complete detail as is contained in the . . . claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226,1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); M.P.E.P. §2131. The elements must be arranged as required by the claim. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); M.P.E.P. §2131. It is respectfully submitted that the Examiner has not met the required legal burden as set forth by the courts to substantiate valid rejections under 35 U.S.C. 102(e).

Independent Claim 20

Regarding claim 20, Appellants submit that De La Motte et al. does not disclose or suggest the limitations in the combination of this claim. For example, the Examiner asserts that De La Motte et al. discloses identifying whether vendors satisfy minimum attributes, in the abstract and paragraphs 31-32. However, this is not identifying other vendors satisfying minimum attributes set by a buyer, as recited in the claims of the present application. In contrast, De La Motte et al. discloses products and factories of suppliers being evaluated by an independent organization (see, column 2, lines 1-4).

Further, the Examiner asserts that De La Motte et al. discloses registering the vendors that satisfy the minimum attributes, at paragraphs 29 and 30. However, these paragraphs merely

disclose that each buyer, supplier and third-party service provider gains access or membership to the system by registering with the system operator, and that registered companies may designate multiple employees or agents as authorized buyers for the company. This is not registering the vendors that satisfy the minimum attributes, as recited in the claims of the present application. These portions of De La Motte et al. disclose that each buyer, supplier, and third-party service provider gains access to the system. These portions do not disclose or suggest anything related to registering vendors that satisfy minimum attributes.

The Examiner further asserts that De La Motte et al. discloses identifying the buyer's vendor selection criteria, by the disclosure of RFQs in paragraphs 13 and 14. However, request for quotes (RFQs) as disclosed in De La Motte et al. are not a buyer's vendor selection criteria, as is cited in the claims of the present application. According to the present invention, a buyer's vendor selection criteria includes information used by the buyer in the selection of a vendor, for example, geographic region, business type, price, etc. (see, claim 21). A buyer's vendor selection criteria is not an RFQ (that specifies objective and subjective aspects of a product) as disclosed in DE.

The Examiner further asserts that De La Motte et al. discloses an engine to select a qualified vendor for the buyer based on the database information and the selection criteria, in paragraphs 32 and 33. However, these portions merely disclose that buyers can activate software filters to screen offers from suppliers based on product type, on supplier, country of origin, etc. This is not an engine to automatically select a qualified vendor for the buyer

based on the database information and the selection criteria, collected from the buyer, as recited in the claims of the present application. According to the present invention, a qualified vendor is automatically selected for the buyer.

In the Response to Arguments section of the Office Action, in response to Appellants' argument that De La Motte et al. does not disclose or suggest identifying whether vendors satisfy minimum attributes set by a buyer, the Examiner states that "DE discloses that the structure and dynamics of the market to both buyers and suppliers are such the need for intermediaries are eliminated. However, since buyers and suppliers may continue to require the services provided by third-parties, the system 100 provides a transactional link through which the services can be retained." Appellants submit that this has nothing to do with vendors satisfying minimum attributes set by a buyer, as recited in the claims of the present application. Further, the Examiner goes on to state that "it is exceedingly clear that DE did not mention in the slightest in col. 2, lines 1-4, products and factories of suppliers being evaluated by an independent organization, contrary to the Appellants assertion in the remarks." Appellants fail to understand this statement by the Examiner in that clearly De La Motte et al. discloses starting at col. 1 in paragraph 12 extending to col. 2, that **"both the products and factories of suppliers are evaluated by an independent, quality-control measurement organization, which applies ratings to the products and factories in accordance with the standardized rating system."** Appellants do not understand the Examiner's comments when the words mentioned by Appellants are the exact words stated in the reference. The Examiner further asserts

that De La Motte et al. discloses identifying vendors satisfying minimum attributes set by a buyer, by DE's remote buyers developing RFQs describing details of the products that they offer. However, attributes of a product are not satisfying minimum attributes of a vendor set by a buyer.

The Examiner further maintains that De La Motte et al. discloses registering vendors that satisfy minimum attributes. However, the Examiner does not address Appellants' remarks and merely continues to state that each buyer, supplier, and third party service provider gains access or membership to the system by registering with the system. As noted in Appellants' previous response, every buyer, supplier, and third-party service provider gains access or membership to the system by registering. This is not registering vendors that satisfy minimum attributes, as recited in the claims of the present application.

Moreover, the Examiner maintains that De La Motte et al. discloses identifying whether vendors satisfy minimum attributes set by a buyer, but as noted in Appellants' previously filed response, that the Examiner does not respond to, De La Motte et al. does not disclose to automatically select a qualified vendor to the buyer based on the database information and the selection criteria collected from the buyer, as recited in the claims of the present application. The software filters disclosed in De La Motte et al. do not disclose or suggest these limitations in the claims of the present application.

Independent Claim 26

Regarding claim 26, Appellants submit that De La Motte et al. does not disclose or

suggest the limitations in the combination of this claim. For example, the Examiner asserts that De La Motte et al. discloses a spatial location engine to determine criteria of a buyer and attributes of a plurality of vendors, in paragraphs 74 and 75. However, these portions merely disclose that the system develops minimum product quality standards by capturing the specified product characteristic ratings transmitted in buyer's RFQ's and suppliers' bids, and details regarding product testing being carried out by an independent quality-control monitoring organization. This is not a spatial location engine to determine criteria of a buyer and attributes of a plurality of vendors, as recited in the claims of the present application. DE's disclosure of developing product quality standards and performing product testing has nothing to do with criteria of a buyer or attributes of a plurality of vendors.

Further, as noted previously, the Examiner asserts that De La Motte et al. discloses registering the vendors that satisfy the minimum attributes, at paragraphs 29 and 30. However, again these paragraphs merely disclose that each buyer, supplier and third-party service provider gains access or membership to the system by registering with the system operator, and that registered companies may designate multiple employees or agents as authorized buyers for the company. This is not registering the vendors that satisfy the minimum attributes, as recited in the claims of the present application. These portions of De La Motte et al. disclose that each buyer, supplier, and third-party service provider gains access to the system. These portions do not disclose or suggest anything related to registering vendors that satisfy minimum attributes.

Independent Claim 34

Regarding claim 34, Appellants submit that De La Motte et al. does not disclose or suggest the limitations in the combination of this claim. For example, the Examiner asserts that De La Motte et al. discloses means for qualifying the first party to a set of minimum attributes, in paragraphs 74 and 75. However, as noted previously, these portions merely disclose that the system develops minimum product quality standards by capturing the specified product characteristic ratings transmitted in buyer's RFQ's and suppliers' bids, and details regarding product testing being carried out by an independent quality-control monitoring organization. This is not means for qualifying the first party to a set of minimum attributes, as recited in the claims of the present application. Developing product quality standards and performing product testing does not disclose or suggest qualifying a party, or a set of minimum attributes.

Dependent Claim 21

Appellants submit that De La Motte et al. does not disclose or suggest wherein the selection criteria comprises geographic region, business type or price. Independent claim 20 is believed to define patentable subject matter as discussed above. This dependent claim depends from independent claim 20 and therefore defines patentable subject matter at least for this additional reason. In addition, this dependent claim recites features that further and independently distinguish over the applied reference. Appellant respectfully submits that this claim stands and falls separately from the respective claim from which it depends.

Dependent Claim 22

Appellants submit that De La Motte et al. does not disclose or suggest notifying the selected vendor of having been selected. Independent claim 20 is believed to define patentable subject matter as discussed above. This dependent claim depends from independent claim 20 and therefore defines patentable subject matter at least for this additional reason. In addition, this dependent claim recites features that further and independently distinguish over the applied reference. Appellant respectfully submits that this claim stands and falls separately from the respective claim from which it depends.

Dependent Claim 23

Appellants submit that De La Motte et al. does not disclose or suggest wherein the notification is through one of e-mail, file transfer protocol, integration technology, DCOM, XML, CORBA, HTTP, wireless devices or instant messaging. Independent claim 20 is believed to define patentable subject matter as discussed above. This dependent claim depends from independent claim 20 and therefore defines patentable subject matter at least for this additional reason. In addition, this dependent claim recites features that further and independently distinguish over the applied reference. Appellant respectfully submits that this claim stands and falls separately from the respective claim from which it depends.

Dependent Claim 24

Appellants submit that De La Motte et al. does not disclose or suggest wherein the buyer provides the vendor selection criteria and a database stores registered vendors that satisfy

minimum attributes. Independent claim 20 is believed to define patentable subject matter as discussed above. This dependent claim depends from independent claim 20 and therefore defines patentable subject matter at least for this additional reason. In addition, this dependent claim recites features that further and independently distinguish over the applied reference. Appellant respectfully submits that this claim stands and falls separately from the respective claim from which it depends.

Dependent Claim 25

Appellants submit that De La Motte et al. does not disclose or suggest wherein the buyer is prompted to input selection criteria through one or more capture forms. Independent claim 20 is believed to define patentable subject matter as discussed above. This dependent claim depends from independent claim 20 and therefore defines patentable subject matter at least for this additional reason. In addition, this dependent claim recites features that further and independently distinguish over the applied reference. Appellant respectfully submits that this claim stands and falls separately from the respective claim from which it depends.

Dependent Claim 28

Appellants submit that De La Motte et al. does not disclose or suggest a vendor notification unit to notify registered vendors of selection criteria entered by the buyer, and a bid accepting unit to receive bids from the registered vendors, wherein the bids are stored in the database, wherein one of the bids and the selection criteria are capable of being jointly tendered by a plurality of cooperating parties. Independent claim 26 is believed to define patentable

subject matter as discussed above. This dependent claim depends from independent claim 26 and therefore defines patentable subject matter at least for this additional reason. In addition, this dependent claim recites features that further and independently distinguish over the applied reference. Appellant respectfully submits that this claim stands and falls separately from the respective claim from which it depends.

Dependent Claim 29

Appellants submit that De La Motte et al. does not disclose or suggest wherein the analyzing unit comprises a dynamically generated application form to be completed by the buyer and submitted to the engine, wherein the spatial location engine and the database use the data from the completed dynamically generated application form to select at least one qualified vendor. Independent claim 26 is believed to define patentable subject matter as discussed above. This dependent claim depends from independent claim 26 and therefore defines patentable subject matter at least for this additional reason. In addition, this dependent claim recites features that further and independently distinguish over the applied reference. Appellant respectfully submits that this claim stands and falls separately from the respective claim from which it depends.

Accordingly, Appellants assert that De La Motte et al. does not disclose or suggest the limitations in the combination of each of claims 20-26, 28-29 and 34 in the present application. Appellants respectfully request that these rejections be reversed and that these claims be allowed.

35 U.S.C. §103 Rejections

The ultimate determination of obviousness under §103 is a question of law. See, In re Leuders, 111 F.3d 1569, 1571, 42USPQ2d 1481, 1482 (Fed. Cir. 1997). The factual predicates underlying an obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art at the time of the invention. See, Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH, 139 F.3d 877, 881, 45 USPQ2d 1977, 1981 (Fed. Cir. 1998).

To reject claims in an application under Section 103, an Examiner must show an un rebutted prima facie case of obviousness. See, In re Deuel, 51 F.3d 1552, 1557, 34 USPQ2d 1210, 1214 (Fed. Cir. 1995). In the absence of a proper prima facie case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. See, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). It is respectfully submitted that the Examiner has not met the required legal burden as set forth by the courts to substantiate valid rejections under 35 U.S.C. 103(a).

Independent Claim 1

Regarding claim 1, Appellants submit that De La Motte et al. does not disclose suggest or render obvious the limitations in the combination of this claim. Regarding the rejection of claims 1 and 3-19, the Examiner summarily bases his support for the rejection of all of these claims on the mere statement in Appellants' background of the invention that purchasing technology has been applied to the Internet. From this simple statement the Examiner then uses

impermissible hindsight in asserting that the limitations in these claims is “old and well known in the art”, and that Applicant is “broadly automating a known method utilizing a known and existing technology”. Appellants submit that the Examiner uses impermissible hindsight in reading the limitations of Appellants’ claims back into the cited prior art. The Examiner provides no references that support his “well known in the art” assertions, and provides no appropriate motivation for one of ordinary skill in the art to combine the disclosure in Appellants’ background of the invention with the concepts of the Internet and specifically the concepts as recited the claims of the present application.

Appellants assert that the Examiner has used impermissible hindsight in making the rejections. The Federal Circuit has forbidden the use of hindsight in the selection of references that comprise the case of obviousness. See, In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). Moreover, as the Federal Circuit has stated in In re Rouffet, 47 USPQ2d 1453 (Fed. Cir. 1998) at pages 1457 and 1458:

As this court has stated, "virtually all [inventions] are combinations of old elements." Environmental Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also Richdel, Inc. v. Sunspool Corp., 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability."

Sensonic, Inc. v. Aerosonic Corp., 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

To prevent the use of hindsight based on the invention to defeat patentability of the invention, the court has required the Examiner to show a motivation to combine the references that create the case of obviousness. In other words, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

Appellants respectfully submit that the Examiner relies on impermissible hindsight as there is no suggestion in the prior art for the features and/or combinations. That is, it is well-founded that when a rejection depends on a combination of prior art references, there must be some teachings, suggestion, or motivation to combine the references. See ACH Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984) and In re Geiger, 815 F.2d, 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987). Appellants believe that there is no teaching, suggestion, or motivation to combine the references (here just Appellants' background and the Internet generally) and the rejection of all the claims should be withdrawn at least for this reason. There is no suggestion in the references to make the combination. Rather, the only motivation is provided in Appellants' own specification. The Office Action can not use Appellants' own specification as a "road map" to find the claimed features. As stated in In re Gorman, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991), the

references themselves must provide some teaching whereby the Appellants' combination would have been obvious. The Office Action therefore relies on impermissible hindsight. The applied references do not contain any teaching whereby the claimed features would have been obvious. Additionally, the Office Action clearly relies on a piecemeal reconstruction of the prior art in order to find claimed features. In view of this, the combination and rejections are improper and should be withdrawn.

Moreover, the Examiner appears to believe that an invention providing an advantage of increased speed and efficiency is not a patentable invention, and also states that the Appellants are not claiming specific features or structures that make the automation possible. Appellants respectfully disagree with these statements. The claims in the present invention clearly recite at least one server that performs the various automatic purchasing functions of Appellants' claimed invention. The Examiner provides no prior art references that disclose or suggest these limitations in the claims of the present application, and further provides no motivation for one of ordinary skill in the art to combine these structures with Appellants' background of the invention. Appellants respectfully submit that the Examiner is required to provide references that support his assertions that the limitations in the claims of the present application are "well known" as well as provide appropriate motivation to combine any asserted references in any attempt to achieve the limitations in the claims of the present application. The Examiner's rejection is improper under 35 U.S.C. §103 due to this failure to provide the required support and motivation.

Independent Claim 8

Regarding claim 8, Appellants submit that De La Motte et al. does not disclose or suggest the limitations in the combination of this claim. As noted previously, the Examiner ignores the details of structure recited in the claims of the present application. The Examiner ignores the details of structure recited in claim 8 directed toward a purchasing system that recites a web server, an internal database, and an external database. The Examiner provides no prior art references that disclose or suggest these limitations in the claims of the present application, and further provides no motivation for one of ordinary skill in the art to combine these structures with Appellants' background of the invention. Appellants respectfully submit that the Examiner is required to provide references that support his assertions that the limitations in the claims of the present application are "well known" as well as provide appropriate motivation to combine any asserted references in any attempt to achieve the limitations in the claims of the present application. The Examiner's rejections are improper under 35 U.S.C. §103 due to this failure to provide the required support and motivation.

Independent Claim 13

Regarding claim 13, Appellants submit that De La Motte et al. does not disclose or suggest the limitations in the combination of this claim. As noted previously, the Examiner ignores the details of structure recited in claim 13 that recites a plurality of region terminals, a plurality of region servers, and a main server. The Examiner provides no prior art references that disclose or suggest these limitations in the claims of the present application, and further

provides no motivation for one of ordinary skill in the art to combine these structures with Appellants' background of the invention. Appellants respectfully submit that the Examiner is required to provide references that support his assertions that the limitations in the claims of the present application are "well known" as well as provide appropriate motivation to combine any asserted references in any attempt to achieve the limitations in the claims of the present application. The Examiner's rejections are improper under 35 U.S.C. §103 due to this failure to provide the required support and motivation.

Independent Claim 16

Regarding claim 16, Appellants submit that De La Motte et al. does not disclose or suggest the limitations in the combination of this claim of, inter alia, an Internet-based joint purchasing method that includes inputting a plurality of orders for an item to purchase; transmitting the inputted orders to a main server; and performing a notice of tender for the item, wherein the plurality of orders are jointly tendered in the notice of tender to a plurality of cooperation companies through the Internet. The Examiner fails to specifically point out where in De La Motte et al. each of these limitations is disclosed or suggested. The Examiner's rejections are improper under 35 U.S.C. §103 due to this failure to provide the required support and motivation.

Dependent Claims 3-7, 9-12, 14, 15 and 17-19

Appellants submit that De La Motte et al. does not disclose or suggest the limitations in the combination of each of these claims. Independent claims 1, 8, 13 and 16 are believed to

define patentable subject matter as discussed above. These dependent claims depend from at least one of these independent claims and therefore define patentable subject matter at least for these additional reasons. In addition, these dependent claims recite features that further and independently distinguish over the applied reference. Appellant respectfully submits that these claims stand and fall separately from the respective claims from which they depend.

Accordingly, Appellants submit that claims 1-19 are patentable over Appellants' background of the invention. Appellants respectfully request that these rejections be withdrawn and that these claims be allowed.

Dependent Claim 27

Appellants submit that De La Motte et al. does not disclose or suggest wherein the registering unit comprises a dynamically generated application form to be completed by a vendor and compared to the set minimum attributes and stored in the database if the vendor meets or exceeds the minimum attributes. Independent claim 26 is believed to define patentable subject matter as discussed above. This dependent claim depends from independent claim 26 and therefore defines patentable subject matter at least for this additional reason. In addition, this dependent claim recites features that further and independently distinguish over the applied reference. Appellant respectfully submits that this claim stands and falls separately from the respective claim from which it depends.

CLAIMS APPENDIX

The attached Claims Appendix contains a copy of the claims involved in the appeal.

EVIDENCE APPENDIX

Appellants have not provided any evidence with this appeal and therefore an Evidence Appendix is not provided.

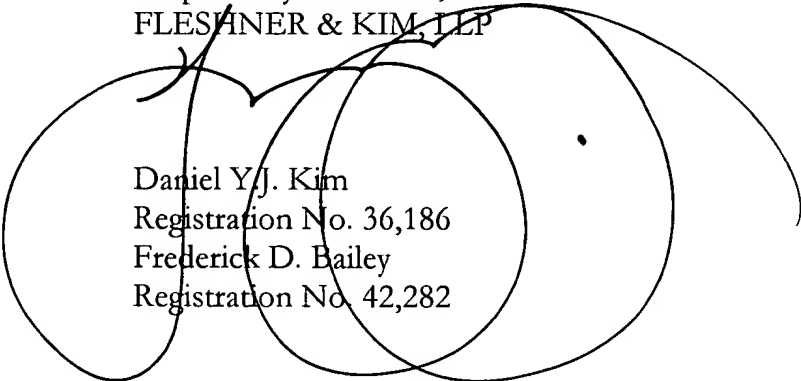
RELATED PROCEEDINGS APPENDIX

Appellants are not providing copies of related decisions and therefore a Related Proceeding Appendix is not provided.

CONCLUSION

It is respectfully submitted that the above arguments show that each of claims 1, 3-29 and 34 are patentable over the applied reference. Based at least on these reasons, it is respectfully submitted that each of claims 1, 3-29 and 34 defines patentable subject matter. Appellants respectfully request that the rejections of claims 1, 3-29 and 34 set forth in the April 7, 2006 Office Action be withdrawn.

Respectfully submitted,
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CLAIMS APPENDIX

1. An Internet-based automatic purchasing method performed on at least one server connected to the Internet, comprising:

inputting a notice of tender by a buyer on a server at a purchasing site, the notice including purchasable items;

applying for a new registration by at least one company desiring to join the tender;

screening the at least one company to determine whether the at least one company applying for a new registration satisfy a certain condition set in advance;

registering the at least one company as cooperation companies when the companies satisfy the certain condition set in advance;

sending a request for quote to the cooperation companies;

sending bids to the purchasing site by the cooperation companies in response to the request for quote; and

selecting a selected cooperation company to supply the purchasable items by automatically screening the registered cooperation companies,

wherein the screening, the registering, the sending the request, and the selecting are all performed automatically by the at least one server.

3. The automatic purchasing method according to claim 1, wherein the at least one company applying for the new registration inputs information on the purchasing site, the

inputted information comprising information related to a “business registration number”, an “establishment date”, a “certification quality standard”, a “business type”, a “representative name”, a “capital”, a main product, or a present employee state.

4. The automatic purchasing method according to claim 1, wherein the screening comprises:

determining whether the bids satisfy certain conditions.

5. The automatic purchasing method according to claim 1, further comprising an ordering process comprising:

determining whether the selected cooperation company satisfies a certain condition by performing a certification test about a desired item; and

ordering the desired item from the selected cooperation company which passed the certification test.

6. The automatic purchasing method according to claim 1, wherein the selected cooperation company is primarily selected by quotation price offered by the cooperation companies included in the bid.

7. The automatic purchasing method according to claim 1, wherein at least one of said servers is operatively connected to an external database for providing information to the cooperation companies, and an internal database for managing the information about the cooperation companies.

8. An Internet-based automatic purchasing system, comprising:
a web server, the web server including a program for controlling the system's operations, the operations including notice of tender operations and ordering operations;
an internal database, the internal database providing information related to purchases; and
an external database, the external database providing information to cooperation companies.

9. The automatic purchasing system according to claim 8, wherein the internal database stores confidential information.

10. The automatic purchasing system according to claim 8, wherein the internal database performs operations related to purchases by passing through a database server.

11. The automatic purchasing system according to claim 8, wherein the external database provides information to the cooperation companies by passing through a database server.

12. The automatic purchasing system according to claim 8, wherein the information related to the purchases comprise at least one of a purchase principal, a purchase procedure, a purchase item, a purchase inquiry, a company introduction, a cooperation company registration and a quotation transmission.

13. An Internet-based joint purchasing system, comprising:
a plurality of region terminals for inputting order information about a purchase item required by a plurality of companies in a prescribed region;
a plurality of region servers for combining and storing the order information from the plurality of region terminals about the purchase item and transmitting the combined order information through a communication network; and
a main server, the main server receiving the combined order information about the purchase item transmitted from the region servers and performing a notice of tender for a joint purchasable item through the Internet to cooperation companies.

14. The joint purchasing system according to claim 13, wherein the joint purchasing system further comprises a parts information database for providing the information related to the purchasable items stored in advance to the cooperation companies through the main server.

15. The joint purchasing system according to claim 13, wherein the main server performs the notice of tender privately when the item is not purchasable jointly.

16. An Internet-based joint purchasing method, comprising:
inputting a plurality of orders for an item to purchase;
transmitting the inputted orders to a main server; and
performing a notice of tender for the item, wherein the plurality of orders are jointly tendered in the notice of tender to a plurality of cooperation companies through the Internet.

17. The joint purchasing method according to claim 16, wherein the performing of the notice of tender further comprises performing a notice of tender privately when the item is not purchasable jointly.

18. The joint purchasing method according to claim 16, wherein the orders are separately inputted from each company.

19. The joint purchasing method according to claim 16, wherein prior to the transmitting of the inputted orders to the main server, the inputted orders are stored on a corresponding region server.

20. A method of matching vendors to buyers through a network, comprising:
identifying whether vendors satisfy minimum attributes set by a buyer;
registering the vendors that satisfy the minimum attributes;
identifying the buyer's vendor selection criteria;
notifying the vendors of the vendor selection criteria;
accepting bids from the vendors; and
selecting, by the buyer, a selected vendor from the vendors that satisfy the minimum attributes according to one or more of the vendor selection criteria.

21. The method of matching vendors to buyers through a network according to claim 20, wherein the selection criteria comprises geographic region, business type or price.

22. The method of matching vendors to buyers through a network according to claim 20, further comprising notifying the selected vendor of having been selected.

23. The method of matching vendors to buyers through a network according to claim 22, wherein the notification is through one of e-mail, file transfer protocol, integration technology, DCOM, XML, CORBA, HTTP, wireless devices or instant messaging.

24. The method of matching vendors to buyers through a network according to claim 20, wherein the buyer provides the vendor selection criteria and a database stores registered vendors that satisfy minimum attributes.

25. The method of matching vendors to buyers through a network according to claim 24, wherein the buyer is prompted to input selection criteria through one or more capture forms.

26. A network based sales generation system, comprising:

- a spatial location engine to determine criteria of a buyer and attributes of a plurality of vendors;
- a registering unit to register vendors which satisfy set minimum attributes;
- a database containing information regarding the registered vendors;
- an analyzing unit to collect selection criteria from the buyer; and
- an engine to automatically select a qualified vendor for the buyer based on the database information and the selection criteria.

27. The network based sales generation system as claimed in claim 26, wherein the registering unit comprises a dynamically generated application form to be completed by a vendor and compared to the set minimum attributes and stored in the database if the vendor meets or exceeds the minimum attributes.

28. The network based sales generation system as claimed in claim 26, further comprising:

a vendor notification unit to notify registered vendors of selection criteria entered by the buyer; and

a bid accepting unit to receive bids from the registered vendors, wherein the bids are stored in the database, wherein one of the bids and the selection criteria are capable of being jointly tendered by a plurality of cooperating parties.

29. The network based sales generation system as claimed in claim 26, wherein the analyzing unit comprises a dynamically generated application form to be completed by the buyer and submitted to the engine, wherein the spatial location engine and the database use the data from the completed dynamically generated application form to select at least one qualified vendor.

34. A method for selecting a first party for a second party for engaging in a transaction, comprising:

means for entering a request identifying at least one criterion for a transaction by the second party through a network;

means for qualifying the first party to a set of minimum attributes;

means for identifying a qualified first party to engage in the transaction based on the at least one criterion;

means for providing an identification of the first and second parties to engage in the transaction.